

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/240,588 02/01/99 GRANDCOLAS

M CITI10035-CON

LM02/0721

EXAMINER

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SUITE 800  
WASHINGTON DC 20005

NGUYEN, N

ART UNIT PAPER NUMBER

2764

DATE MAILED:

07/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/240,588	Applicant(s) Grandcolas et al.
Examiner Nga B. Nguyen	Group Art Unit 2764

Responsive to communication(s) filed on Mar 29, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 14-21 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 14-21 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

1. This Office Action is in response to the communication received on 03/29/1999 (the Preliminary Amendment), which paper has been placed of record in the file.
2. Claims 1-13 are canceled. Claims 14-21 are pending in this application.

### ***Specification***

3. Claim 14 is objected to because of the following informalities: Spelling error. At line 2, “canoncial” must be replaced to “canonical”. Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 14-21 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 5,867,153 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The main subject matters claimed in the instant application are fully/ inherently/obviously disclosed in U.S. Patent 5,867,153 and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A system and method of interfacing a plurality of different access devices for distributing information to a plurality of customers comprising: an application for providing data in response to a request for data; a plurality of different access devices for each of the plurality of customers; parsing a data stream from the desired application; creating a token representation of the data stream from the desired application; forwarding the token representation to one of the plurality of access devices; ...

The examiner submits that claims 14-21 in the instant application have similar meaning to claims 1-13 which is within the breadth and scope of definition claimed in the prior patent (U.S. Patent 5,867,153). If allowed, the claims 14-21 of the instant application, not only would provide patent protection but would also extend patent coverage to the combination of claims 14-21,

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already disclosed and covered by the claims in the previous patent. Thus, the controlling fact is that patent protection for the method/system, fully disclosed in and obviously covered by the claims of the prior paten, would be extended by the allowance of the claims in this application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

### ***Conclusion***

6. Claims 14-21 are rejected.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703) 306-2901.

The examiner can normally be reached on Monday-Friday from 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

8. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231

**or faxed to:**

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(703) 308-9051, (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,  
2121 Crystal Drive, Arlington.

VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Group receptionist whose telephone number is (703)305-3900.

Nga B. Nguyen  
July 14, 1999

James P. Hammell  
Supervisory Patent Examiner  
Technology Center 2700